

REMARKS

Claims 4, 15, 26, 35 and 38 have been canceled without prejudice to their being included in a continuation application.

The dependency of claims 5, 16, 27 and 39 has been changed in view of the foregoing cancellations.

Applicant respectfully requests entry of the amendments.

In the Office action, the claims were rejected as follows:

(1) Claims 3, 14, 25 and 37 were rejected under 35 U.S.C. § 102 as anticipated by U.S. Patent No. 6,578,012 (Storey).

(2) Claims 4-7, 9-10, 15-18, 20-21, 26-29, 31-32, 38-41 and 43-44 were rejected under 35 U.S.C. § 103 as unpatentable over the information from the Successories.com web site in view of U.S. Patent No. 7,013,289 (Horn et al.) and further in view of published US patent application 2003/0055871 (Roses).

(3) Claims 8, 11, 19, 22, 30, 33, 42 and 45 were rejected under 35 U.S.C. § 103 as unpatentable over the Successories.com material in view of the Horn et al. patent in further view of the Roses application and U.S. Patent No. 6,665,587 (Leone et al.).

The rejections of claims 4, 15, 26, 35 and 38 are moot in view of those claims having been canceled.

Claims 3, 13, 25 and 37 are not anticipated by the Storey patent

A claim is anticipated under 35 U.S.C. § 102 only if "each an every" element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. MPEP § 2131. As discussed below, that is not the case here. Indeed, as discussed below, the

subject matter of claims 3, 13, 25 and 37 is significantly different from the disclosure of the Storey patent.

Claim 3, for example, recites a method that includes providing an on-line, interactive network site including a personalized network page from which a user can customize and personalize specifications for a three-dimensional achievement recognition item. The personalized network page includes a pre-populated list of one or more achievements attained by the user, any of which the user can select for customizing and personalizing the achievement recognition item.

The method also includes receiving information through the network site from the user. The information includes user-selected specifications for customizing and personalizing features of the achievement recognition item for an achievement selected by the user from the pre-populated list.

The Office action alleges (at page 3) that the accumulation of award points in the Storey patent corresponds to the claimed "achievement." That is incorrect.

In particular, claim 3 recites that the achievement is "selected by the user" from a pre-populated list. In contrast, according to the Storey patent, the user does not "select" the accumulated points. Instead, the user selects an award or product (col. 5, lines 58-62), and then the system automatically determines the number of points still needed by the user if he wishes to acquire the selected award or product.

At least for that reason, the Storey patent does not anticipate claim 3.

Furthermore, claim 3 recites that the achievement recognition item is "for an achievement" attained by the user. Thus, the achievement recognition item recognizes an achievement attained by the user. Examples disclosed in the present application include a plaque with a laminated document affixed to a substrate, where the document includes a certificate, an award, a diploma, a published article or other document that reflects an award or other achievement attained by the individual user or group with which the user is associated.

If, as argued by the Office action, the “achievement” in the Storey patent is the accumulation of points, then the award or product (which allegedly corresponds to the claimed “achievement recognition item”) should recognize the user's having accumulated a certain number of points. But that is not the case in the Storey patent. Instead, according to the Storey patent, the award or product selected by the user does not itself indicate in any way that the user attained any particular level of points. For example, there is no indication that someone looking at the award or product would understand that the user has attained some achievement. Therefore, the award or product disclosed by the Storey patent is not “an achievement recognition item,” and even if it were, it is not “for an achievement” selected by the user.

For this additional reason, the Storey patent does not anticipate claim 3.

Claim 3 also refers to a “pre-populated list” of one or more achievements attained by the user. The cited reference does not disclose such a “pre-populated list” of achievements. That is because, according to the Storey patent, the number of points attained by the user is calculated and displayed in the manner disclosed at col. 5, lines 43-53 and col. 8, lines 8-29. Therefore, even if the level of points attained by the user were considered an “achievement,” the cited reference does not include a personalized page with a “pre-populated list” of achievements attained by the user.

Claim 3 further recites that the information received from the user through the network site includes user-selected specifications for “customizing and personalizing” features of the achievement recognition item. Examples of customizing and personalizing features of the achievement recognition item are described in the present application as follows:

Several buttons 64, 66 and associated links appear on the web page 58 to allow the prospective customer to customize and personalize various features of the plaque 62 (or other achievement item) for the selected achievement. For example, to customize the plaque 62, the user would select the button 64. In response to the user's clicking on the button 64 using, for example, an electronic mouse coupled to the user's device 42, the system retrieves and displays another

web page 70 (FIG. 5) on the user's device. The user may select the color of the trim 24 and bevel 28 from among two or more options by clicking the appropriate selection 72. In the illustrated example, the user may choose either gold or silver trim. The user also may select the wood finish for the substrate 22 from among two or more options by clicking on an appropriate selection 74. In the illustrated example, the user may select mahogany, black, natural, maple or walnut as the wood finish.

* * *

To personalize the plaque, the user would select the button 66. In response to the user's clicking on the button 66, the system retrieves and displays another web page 80 (FIG. 6) on the user's device. The page 80 allows the prospective customer to personalize the text that will appear on the laser-engraved plate 30 for the plaque. The text appearing on the plate 30 typically would relate to the achievement attained by the user. . . .

(Specification, pages 11-13) The Office action (at page 4) points to col. 9, line 62 – col. 10, line 6 of the Storey patent as allegedly disclosing the claimed features of “customizing and personalizing.” That is incorrect.

The Storey patent discloses that the user can select the color and size of the award. Thus, although the Storey patent may disclose “customizing” the award, that patent says nothing about “personalizing” the award.

For the foregoing additional reasons, claim 3 is not anticipated by the Storey patent.

None of the other cited references disclose the features missing from the Storey patent.

Independent claims 14, 25 and 37 recite similar features as those discussed with respect to claim 3. Therefore, those claims should be allowed as well.

The remaining claims depend directly or indirectly from claim 3, 14, 25 or 37. Accordingly those claims should be in condition for allowance as well.

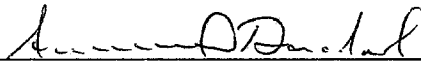
Conclusion

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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